

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

Jerding, et al.

Serial No.: 09/590,488

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Confirmation No.: 2510

Group Art Unit: 2623

Examiner: Beliveau, Scott E.

Docket No.: A-6600 (191910-1540)

For: **User Interface Navigational System With
Parental Control For Video On Demand System**

REPLY BRIEF UNDER 37 C.F.R. §41.41

Mail Stop Appeal Brief - Patents
Commissioner of Patents and Trademarks
P.O. Box 1450
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Sir:

This is a Reply Brief in response to the Examiner's Answer dated January 11, 2008.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that additional fees are required, beyond those which may otherwise be provided for in the documents accompanying this paper. However, in the event that additional fees are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required (including fees for net additions of claims) are hereby authorized to be charged to 20-0078.

REMARKS

The Examiner's Answer maintains the rejections of the claims and generally repeats the arguments advanced during prosecution of this application. The Examiner's Answer also provides comments to the Appeal Brief (in the Response to Argument Section, pages 11-22 of the Examiner's Answer). Appellant disagrees with the substantive remarks of the Examiner's Answer. Appellant addresses herein some of the issues raised in the Examiner's Answer. Appellant continues to repeat, re-allege, and incorporate by reference the positions and arguments set forth in the Appeal Brief.

I. Meaning of "Responsive to"

In discussing the term "responsive to", used in independent claim 74, the Examiner argues that:

Appellants contend that the rejection is in error because claim 74 contains several actions ("determining", "providing", and "establishing") that are "responsive to" certain conditions which define a particular process flow. However, the claims do not require the degree to which the actions are in fact 'responsive to' the conditions (i.e. directly responsive to versus indirectly responsive to). The instant application also provides no special definition regarding the meaning of the phrase 'responsive to'. Appellants, argue that a step "responsive to" another must not only occur later in time (sequentially), but must also be performed as a result of the first step being performed even if intervening steps are possible due to the open ended language of the claim.) Appellants have not previously proposed this two-pronged definition nor has any evidentiary support for this definition been presented throughout prosecution.
(Examiner's Answer, p. 12)

Appellant agrees with the Examiner's statement that "the claims do not require the degree to which the actions are in fact 'responsive to' the conditions (i.e. directly responsive to versus indirectly responsive to)". Appellant also agrees that no special definition is provided in the instant application.

However, Appellant relies on nothing more than the ordinary meaning of the term "responsive to" in asserting that a step "responsive to" another must not only occur later in time,

but must also be performed as a direct or indirect result of the first step being performed. As only ordinary meaning is relied on, Appellant submits that no evidentiary support is required.

The Examiner further argues that:

The definition, in light of the claims, is not consistent with the specification given that the specification discloses that the steps/functions of the process flow may occur out of the illustrated order (IA: Page 66, Lines 3-8).

(Examiner's Answer, p. 12)

Therefore, in light of the process flow of Figures 5A, 5B, and 6, being 'responsive to' appears to be more reasonably construed merely as an ordered operation of process steps wherein certain steps are performed indirectly following or in return to the condition having occurred.

(Examiner's Answer, p. 13)

Appellant submits that the Examiner is improperly importing limitations from the specification into the claims. "Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004). Particular embodiments may or may not perform particular steps in the same order illustrated in the flow charts. However, the language of the claims themselves specifies that some steps perform actions which are responsive to other actions, where the plain language of the phrase "responsive to" implies an action taken as a result of another. To the extent that the Examiner's rejection of claim 74 ignores this result aspect of the phrase "responsive to" and interprets "responsive to" as requiring only that one action follow another, Applicants maintain that the rejection is improper and should be withdrawn.

II. Rejection of Claim 74 under § 103: Metz et al., Goode et al., Switz et al., and Dunn et al.

Claim 74 includes the feature "responsive to a digital home communication terminal (DHCT) experiencing a reboot condition, determining if at least one video-on-demand (VOD) rental has been purchased and has not expired". The rejection of claim 74 on in the Examiner's Answer alleges that this feature is taught by the combination of *Metz et al.* and *Goode et al.* The rejection treats the claimed condition "a digital home communication terminal (DHCT) experiencing a reboot condition" (allegedly taught by *Metz et al.*) as separate from the claimed action "determining if at least one video-on-demand (VOD) rental has been purchased and has not expired" (allegedly taught by *Goode et al.*) which occurs "responsive to" the claimed condition. Having parsed this claimed feature into two pieces, the Examiner then re-combines the two pieces and alleges that the combination teaches the entire claimed feature. The reasoning used in the Examiner's Answer will be discussed below.

A. Teachings of Metz et al.

The rejection alleges that "a digital home communication terminal (DHCT) experiencing a reboot condition" is taught by *Metz et al.*:

In consideration of claims 74 and 89, the Metz et al. reference discloses a method implemented via a "digital home communication terminal (DHCT)" [100] comprising "memory" [120/115] and "programming code stored in said memory" (Col 20, Lines 12- 59). "Responsive to [the DHCT] . . . experiencing a reboot condition" (Col23, Lines 20-22; Col23, Lines 62-65; Col 36, Lines 37-41), the DHCT [100] is operable to provide and support video-on-demand services (Col24, Lines 10- 17). The reference, however, is silent with respect to further processing of VOD rentals as claimed. (Examiner's Answer, p. 3, line 15 to p. 4, line 2.)

Metz et al. discloses that it is known in the art for a set-top terminal to detect failures associated with self- diagnostics and perform upgrade processing for software application which control functions including video-on-demand (VOD)(Col24, Lines 10- 17; Col34, Lines 23-30). In conjunction with upgrading or reloading the operating system and associated software applications, the set-top terminal requires a 'reboot'. It does not perform any further operation until it has successfully 'rebooted' (Col 23, Lines 4-23).

Consequently, Metz et al. does in fact teach a scenario whereby "responsive to a digital home communication terminal (DHCT)

experiencing a reboot condition" the terminal resumes its normal operations, which include the provision of VOD services/applications. The examiner concluded that Metz et al. is simply silent with respect to what the particular operation of VOD services entails once the terminal does in fact continues its operations 'responsive to...experiencing a reboot condition'.

(Examiner's Answer, p. 14, lines 8-19.)

Appellant agrees that the cited passages in *Metz et al.* describe a DHCT rebooting.

Applicant also agrees that the DHCT in *Metz et al.* provides video-on-demand services.

However, Appellant disagrees with the Examiner's conclusion that the providing of video-on-demand in *Metz et al.* occurs "responsive to" the reboot condition. While the DHCT of *Metz et al.* may provide video-on-demand after rebooting, this behavior alone does not read on "responsive to [the DHCT] experiencing a reboot condition", for at least the reasons argued above in Section I.

Appellant also disagrees with the Examiner's statement that "Metz et al. is simply silent with respect to what the particular operation of VOD services entails once the terminal does in fact continues its operations 'responsive to...experiencing a reboot condition' ". To the contrary, several passages in *Metz et al.* do describe the behavior of DHCT responsive to a reboot, and each of these passages describe the behavior resulting from a reboot to be part of an upgrade process. *Metz et al.* includes seven separate descriptions of behavior resulting from a reboot (reproduced below, emphasis added):

However, if the version number for the operating system broadcast on the network differs from the version number of the operating system currently running in the DET 102, then the DET proceeds with the upgrade process...The microprocessor checks for errors in the version now loaded to non-volatile memory, and if error free, the microprocessor reboots to begin running under the new operating system.

(Col. 10, lines 5-10.)

Rather than booting up the operating system in the system memory 120, the microprocessor detects the bit pattern defining sector access to the DET's internal flash memory in the memory of the PCMCIA card and uses that bit pattern to initiate a sector by sector rewrite of the operating system. Specifically, the operating system stored on the PCMCIA card is transferred sector by sector to the flash memory in the DET 102. The

microprocessor then initiates a reboot of the operating system from the internal flash memory to run the new operating system.
(Col. 23, lines 10-25.)

When turned 'OFF' after use, the DET returns to the low power standby state, and the HDT 230 will retain last channel viewed data in memory for use as the initial channel selection when the user next turns the DET ON. As part of the return to the low power state, the microprocessor 105 may repeat the self-diagnostics procedure and reboot the operating system.
(Col. 23, lines 55-65.)

The DET microprocessor 110 compares the operating system version number in the network table with the operating system version number stored in its associated system memory 120 to determine whether or not they match. If they match, an operating system upgrade is not necessary at this time, and the processing routine is complete. Therefore processing branches to step S10; and the microprocessor reboots the existing operating system from NVRAM 121, executes the normal set of associated self-diagnostics, and completes the upgrade processing.
(Col. 36, lines 30-45.)

If extraction is not successful as indicated by a valid checksum in step S6 by the predetermined number of attempts, the microprocessor will terminate running of the upgrade routine and will reboot the existing operating system still stored in the NVRAM 121.
(Col. 37, lines 50-60.)

If the checksum operation produces a 'valid' result indicating no errors are present in the operating system now loaded into flash memory 121, the operating system has been successfully loaded, and the microprocessor 110 therefore initiates a reboot routine (step S10). As a result of the reboot, the microprocessor begins running the new operating system from the flash memory, and the upgrade procedure is complete.
(Col. 38, lines 30-40.)

If the upgrade procedure began automatically after the user turned the set-top 100 'OFF', then the DET 102 returns to its low power stand-by state after reboot. If the upgrade procedure began as a result of the manual activation, then the DET 102 utilizes the last channel viewed data to resume audio/video output. Since the upgrade routine utilized a channel selection procedure for channel 0, the DET 102 will begin outputting the signals to display the audio/video information for the program guide from that channel.
(Col. 38, lines 55-60.)

When the reboot operation is complete, the DET begins execution of the new operating system.
(Col. 39, lines 5-10.)

Appellant therefore submits that *Metz et al.* teaches that various features related to an upgrade process – not features related to providing video-on-demand services – are performed responsive to a reboot condition.

B. Teachings of *Goode et al.*

The rejection alleges that "determining if at least one video-on-demand (VOD) rental has been purchased and has not expired" is taught by *Goode et al.* This point was argued in the Appeal Brief, and the argument will not be repeated here. The remainder of this discussion will assume, for the sake of argument, that *Goode et al.* teaches this feature.

C. Combination of *Metz et al.* and *Goode et al.*

Even assuming, for the sake of argument, that *Metz et al.* teaches the "determining" feature discussed above, the combination does not teach the entire "responsive to....determining" feature. The Examiner's Answer ties together the "determining if at least one video-on-demand (VOD) rental has been purchased and has not expired" with the "responsive to a digital home communication terminal (DHCT) experiencing a reboot condition" as follows:

Goode et al. teaches that "determining if at least one [VOD] rental has been purchased and not expired" is a known technique/operation for VOD systems (Figure 1 1; Col 17, Line 55 - Col 18, Line 33). This technique was recognized as part of the ordinary capabilities of one skilled in the art so as to allow a viewer to watch a remainder/entirety VOD presentation that has been purchased. The examiner subsequently concluded that one having ordinary skill in the art would have subsequently found it obvious to provide this predictable functionality as part of the VOD software application of Metz.

As previously noted, the open ended nature of the claims does not require that immediately after rebooting that the 'determining' step be performed. An inoperative terminal cannot perform the 'determining' step without being first repaired. Any further operation of a terminal that became inoperative is necessarily 'responsive to' the terminal experiencing a reboot condition. Therefore, the examiner concluded that the combination of references (i.e. a Metz rebooting terminal that continues to offer VOD functionality after rebooting) having been modified to provide a particularly known VOD function after having been reboot (i.e. the VOD functionality of Goode) teaches the claimed limitation. Accordingly, it is the examiner's opinion that the claimed step is met. (Examiner's Answer, p. 14, line 20 to p. 15, line 14.)

Appellant agrees with the Examiner's statement that "the open ended nature of the claims does not require that immediately after rebooting the determining step be performed" (emphasis added). However, Appellant does not agree that combining the rebooting terminal described in

Metz et al. with the VOD functionality described in *Goode et al.* teaches the claimed limitation.

To meet the claimed limitation, the terminal in *Metz et al.* would have to provide VOD functionality "responsive to rebooting". However, as argued above, *Metz et al.* teaches that the behavior that occurs "responsive to" (as a result of) rebooting is an upgrade process. While *Metz et al.* does describe the terminal as providing VOD functionality, and so presumably provides this functionality after a reboot, *Metz et al.* does not teach that this VOD functionality is responsive to a reboot.

Furthermore, even assuming, for the sake of argument, that the combination of *Metz et al.* and *Goode et al.* does result in the claimed feature, Appellant submits that the Examiner has not clearly articulated the reason why the claimed features discussed above would have been obvious, as is required by law. The MPEP provides:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (MPEP 2141.)

The Examiner's Answer (p. 5, line 19 to p. 6, line 3) offers two alternative rationales for combining *Metz et al.* and *Goode et al.*:

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Metz et al.* such that "responsive to a home digital home communication (DHCT) experiencing a reboot condition" to perform to associated steps of *Goode et al.* for the purpose of providing a cost effective means for distributing video-on-demand and other information services in a manner which allows for the contemporaneous viewing/sharing of a requested movie (*Goode et al.*: Col 1, Line 66 - Col 2, Line 22). Alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Goode et al.* so as to perform its particular operations "responsive to a digital home communication terminal (DHCT) experiencing a reboot condition" for the purpose of desirably providing a

means to periodically update the operating system software of the operating terminals (Metz et al.: Col4, Lines 7-36).
(Examiner's Answer, p. 5, line 19 to p. 6, line 3)

Both rationales are both incomplete and improper in view of the established standards for rejections under 35 U.S.C. § 103. The first proffered rationale merely cites a benefit that would result from the combination, and this is an improper basis for asserting the obviousness of the combination. The second proffered rationale amounts to nothing more than a conclusory statement that it would be obvious to modify *Goode et al.* having feature X and *Metz et al.* having feature Y to obtain the combined feature X+Y. In summary, the Examiner has failed to explain why a person of ordinary skill in the art would be motivated to combine the particular VOD features of *Goode et al.* with the particular reboot feature of *Metz et al.*

CONCLUSION

Based upon the foregoing discussion, Appellant respectfully requests that the Examiner's final rejection of claims 74-95 be overturned by the Board, and that the application be allowed to issue as a patent with all pending claims.

Respectfully submitted,

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